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10/773,258	02/09/2004	Valeric de la Poterie	05725.0598-01	7152

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EXAMINER

CHANNAVAJJALA, LAKSHMI SARADA

ART UNIT PAPER NUMBER

1615

DATE MAILED: 11/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/773,258

Applicant(s)

POTERIE ET AL.

Examiner

Lakshmi S. Channavajjala

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Receipt of remarks and declaration both dated 8-23-05 is acknowledged.

Claims 1-31 are pending in the instant application.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-31 are have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-14 and 21-31 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,361,782 ('782).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

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Instant claims are directed to a composition comprising a surface stabilized polymer particles dispersed in a fatty liquid phase. '782 disclose a cosmetic composition comprising a surface stabilized polymer dispersed in a liquid fatty phase and teaches the same polymers and fatty materials for preparing the dispersion (col. 6, col. 7, line 1-18). '782 disclose greater than 2% polymers (col. 3, lines 55-67) so as to form a film and trap cosmetic additives such as dyestuffs. Instant claims recite at least 2% polymer concentration, which encompasses percentages above 2% of '782 and for the same "film-forming" purposes. '782 also describe the same stabilizers that are claimed in the instant applications (col. 9, lines 60 through col. 11). '782 also disclose the claimed animal, vegetable and mineral oils (col. 7, lines 52-col. 8, lines 20) and volatile oils such as isododecane. '782 also discloses anhydrous composition, with the claimed additives such as dyestuffs, fillers etc., and the composition for the same use i.e., for caring hands, face etc (col. 14). With respect to the claimed viscosity and solubility parameters, the composition of '782 involves the same polymers, stabilizers, additives, solvents etc., and in the same percentages and hence the viscosity and solubility are inherent to the composition of '782.

Claims 1-16 and 21-31 are rejected under 35 U.S.C. 102(e) as being anticipated by US 5,851,517 to Mougin et al ('517).

Instant claims are directed to a composition comprising a surface stabilized polymer particles dispersed in a fatty liquid phase. '517 disclose a cosmetic composition comprising a surface stabilized polymer dispersed in a liquid fatty phase and teaches

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the same polymers, stabilizers and fatty materials for preparing the dispersion (col. 1 and col. 4-5). '517 disclose the solubility parameters of the composition that read on the instant claimed solubility (col. 3, lines 7-35). '517 disclose the claimed animal, vegetable and mineral oils (cols. 3 and 5) and volatile oils such as isododecane. '517 also disclose claimed additives such as dyestuffs, fillers etc., and the composition for the same use i.e., for hair and eyelashes etc (col. 6). With respect to the amount of the polymer, '517 disclose greater than 2% polymers (examples) and thus meet the claimed limitation. With respect to the claimed viscosity the composition of '517 involves the same polymers, stabilizers, additives, solvents etc., and in the same percentages and hence the viscosity is inherent to the composition of '517.

Claims 1-17 and 21-31 are rejected under 35 U.S.C. 102(e) as being anticipated by US 5,945,095 to Mougin et al ('095).

'095 disclose a cosmetic composition for make-up, including mascara, comprising a dispersion of a surface-stabilized polymer particles and a fatty substance (col. 10). The surface-stabilized polymers include those in the instant claims (col. 4, col. 7), and the liquid fatty substances include the claimed oils, fatty acid esters, silicone oils etc (lines bridging cols. 4-5), comprising the same solubility parameters as that claimed (col. 5). With respect to the claimed amount of the polymer, examples of '095 recite an amount that is above 2% of the total weight of the composition. '095 further teach the claimed additives in their composition and also anhydrous compositions (examples). With respect to the claimed viscosity the composition of '095

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involves the same polymers, stabilizers, additives, solvents etc., and in the same percentages and hence the viscosity is inherent to the composition of '517.

***Claim Rejections - 35 USC § 103***

Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,851,517 to Mougin et al ('517).

'517 discussed above fail to exemplify the claimed fatty acid esters, fatty alcohols, silicone oils of the instant claims. However, '517 teach the claimed fatty acids, fatty alcohols and silicon oils as suitable ingredients in the fatty phase (col. 9).

Therefore, It would have been obvious for one of an ordinary skill in the art at the time of the instant invention to choose the claimed fatty esters, alcohol and specific silicone oils in preparing the composition of because '517 teaches all of the above fatty esters as equivalent in their solubilizing efficacy and compatibility with the surface-stabilized polymer (col. 7).

Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,945,095 to Mougin et al ('095).

'095 discussed above fail to exemplify the claimed fatty acid esters, fatty alcohols, silicone oils of the instant claims. However, '095 teach the claimed fatty acids, fatty alcohols and silicon oils as suitable ingredients in the fatty phase (col. 7-9).

Therefore, It would have been obvious for one of an ordinary skill in the art at the time of

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the instant invention to choose the claimed fatty esters, alcohol and specific silicone oils in preparing the composition of because '095 teaches all of the above fatty esters as equivalent in their solubilizing efficacy and compatibility with the surface-stabilized polymer (col. 7).

The following double patenting rejection has been maintained:

Claims 1-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-47 of U.S. Patent No. 5,945,095.

Claims 1-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,361,782.

Both the references claim cosmetic compositions comprising surface-stabilized polymers prepared as dispersion in a liquid fatty phase. The patented claims recite the instant claimed polymers, fatty phase ingredients and other cosmetic additives. '095 claims solubility and viscosity parameters that are within the claimed range (dependent claims of the patent). Further, '782 claims viscosity and the percentage of polymer particles. Accordingly, the claimed viscosity is inherent to the composition of '782 that recites the claimed percentage of polymer and the amount of polymer claimed is inherent to the polymer claimed in '095 because the viscosity is within the claimed range.

***Response to Arguments***

Applicant's arguments filed 8-23-05 have been fully considered but they are not persuasive.

Double patenting rejection:

US 5,945,095 and US 6,361,782: Applicants argue that the references fail to teach the viscosity and percentage parameters, as stated by the rejection and that the conclusory statement does not raise the level of showing a "clear and particular" evidence of obviousness and that the office used hindsight to reach its conclusion. Applicants' arguments are not persuasive because both the references teach the same surface-stabilized polymers, fatty phase containing the claimed oils, esters, and other volatile oils for preparing a dispersion comprising surface stabilized polymer. Therefore, as explained above, the percentage of polymer and viscosity claimed are inherent to the compositions of '095 and '782.

Obviousness rejections: U.S. Patent No. 5,851,517 and US 6,361,782:

Applicants' arguments regarding the non-obviousness of the instant claims over the cited US patents have been considered but not found persuasive. In particular, as explained in the preceding paragraphs, '782 disclose greater than 2% surface-stabilized polymers (col. 3, lines 55-67) and same stabilizers so as to form a film and trap cosmetic additives such as dyestuffs, and for the same "film-forming" purposes. '782 also disclose the claimed animal, vegetable and mineral oils (col. 7, lines 52-col. 8, lines 20) and volatile oils such as isododecane. The office is not equipped to measure the



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viscosity of the surface-stabilized polymer of '782. However, the composition of '782 involves the same polymers, stabilizers, additives, solvents etc., and in the same percentages and hence the viscosity and solubility are inherent to the composition of '782. Similarly, '517 also disclose the claimed composition with the claimed percentages of the surface-stabilized polymers and accordingly, the claimed viscosity s inherent to the composition of the reference.

With respect to the declaration submitted by Dr. Arditty regarding the measurement of the viscosity, examiner notes that applicants presented measurement of viscosity of the composition of Example 1 of the '517 using the method of measurement disclosed in the present application. Applicants argue that viscosity of '517 is outside the range claimed in the instant application. However, the above arguments are not persuasive because, the '517 patent teaches example 7, which is also cited in the instant specification and hence is a part of the instant specification. Both the examples 1 and 7 of the patent '517 and instant specification employ the same polymer i.e., Kraton G1701. However, the declaration shows that the polymer particles formed from the examples of '517 and instant composition are different and it appears that the difference is due to the solvent used. The declaration presented above uses a different solvent (heptane) instead of isododecane. Thus, it is not clear if the differences seen in the viscosity are due to the polymer employed or due to the solvent. While instant specification describes that the same polymer of '517 has been used instant specification, it is unclear why the viscosity was different from that claimed. Examiner

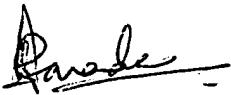
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requests a detailed explanation as to the monomer that makes up the polymer of instant as well as that of the comparative, that results in the claimed viscosity.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 9.00 AM -6.30 PM

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lakshmi S Channavajjala  
Examiner  
Art Unit 1615  
November 8, 2005